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| 09/383,775      | 08/26/1999  | MARC IRA LIPTON      | A00404-1            | 7026             |

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EXAMINER

SWERDLOW, DANIEL

|          |              |
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| ART UNIT | PAPER NUMBER |
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2644

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/383,775

Applicant(s)

LIPTON ET AL

Examiner

Daniel Swerdlow

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 August 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 46-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-63 is/are rejected.
- 7) ☒ Claim(s) 47,49,51,56,58 and 60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore,

- the muting of audio input in response to handset being removed
- the unmuting of audio input in response handset being replaced
- the muting of audio input in response to hook switch being released
- the unmuting of audio input in response hook switch being depressed

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claims 47, 49, 51, 56, 58 and 60 are objected to because of the following informalities:

3. Claim 47, as written, depends on Claim 44, which has been cancelled. It appears that Claim 47 is intended to depend on Claim 46. For the purpose of this Office action, Examiner assumes Claim 47 depends on Claim 46.

4. Claim 49, as written, depends on Claim 46, which claims a method. Claim 49 claims an apparatus. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process"

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nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. It appears that Claim 49 is intended to depend on Claim 48. For the purpose of this Office action, Examiner assumes Claim 49 depends on Claim 48.

5. Claim 51, as written, depends on Claim 48. Claim 51 recites the limitations "the article of manufacture" and "the computer readable data". There is insufficient antecedent basis for these limitations in Claim 48. It appears that Claim 51 is intended to depend on Claim 50. For the purpose of this Office action, Examiner assumes Claim 51 depends on Claim 50.

6. Claim 56, as written, depends on Claim 53, which claims an apparatus. Claim 56 claims a method. As stated above apropos of Claim 49, this is an improper combination. It appears that Claim 56 is intended to depend on Claim 55. For the purpose of this Office action, Examiner assumes Claim 56 depends on Claim 55.

7. Claim 58, as written, depends on Claim 55, which claims a method. Claim 58 claims an apparatus. As stated above apropos of Claim 49, this is an improper combination. It appears that Claim 58 is intended to depend on Claim 57. For the purpose of this Office action, Examiner assumes Claim 58 depends on Claim 57.

8. Claim 60, as written, depends on Claim 57. Claim 60 recites the limitations "the article of manufacture" and "the computer readable data". There is insufficient antecedent basis for these limitations in Claim 57. It appears that Claim 60 is intended to depend on Claim 59. For the purpose of this Office action, Examiner assumes Claim 60 depends on Claim 59.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 46 through 49, 52, 53, 55 through 58, 61 and 62 are rejected under 35 U.S.C.

103(a) as being unpatentable over Gorman et al. (US Patent 4,497,980) in view of Shenk (US Patent 2,561,950).

11. Claim 46 claims a method comprising providing a telephone apparatus having a handset, a handset-receiving portion and a hands-free audio interface. Gorman discloses an apparatus that corresponds to the telephone apparatus claimed and has a handset (Fig. 1, reference HANDSET), a hook (column 2, lines 53-56) that corresponds to the handset-receiving portion claimed, and a handsfree capability (column 1, lines 58-61) that corresponds to the hands-free audio interface claimed. Claim 46 further claims the method comprises communicating audio input and output of a telephone call via the hands-free audio interface while the handset is received by the handset-receiving portion. Gorman discloses a handsfree mode operable when the handset is on hook (i.e., received by the handset-receiving portion) (column 2, lines 57-63). Claim 46 further claims muting the audio input and maintaining the audio output in response to the handset being removed from the handset-receiving portion. Gorman discloses a manual microphone switch (Fig. 3, reference MIC; column 4, lines 50-54) that, when closed, mutes the transmit path (i.e., the audio input) while not affecting the receiving path (i.e., the audio output). Therefore, Gorman anticipates all elements of Claim 46 with the exception of muting the audio output in

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response to the handset being removed from the handset-receiving portion. Shenk discloses a switch (Fig. 14, reference 94, 95, 96; column 5, lines 38-44) closed by removal of a telephone handset. It would have been obvious to one skilled in the art at the time of the invention to apply handset position-based actuation as taught by Shenk to the manual microphone switch in the apparatus taught by Gorman for the purpose of reducing the number of switches required on the manual inputs portion of the apparatus.

12. Claim 47 claims the method of Claim 46 further comprising unmuting the audio input in response to the handset being replaced. As stated above apropos of Claim 46, the combination of Gorman and Shenk meets all elements of that claim. In addition, the manual microphone switch disclosed by Gorman unmutes the transmit path when opened and the switch disclosed by Shenk opens when the handset is replaced. Therefore the combination meets all elements of Claim 47.

13. Claim 48 is essentially similar to Claim 46 and is rejected for the reasons stated above apropos of Claim 46.

14. Claim 49 is essentially similar to Claim 47 and is rejected for the reasons stated above apropos of Claim 47.

15. Claim 52 is essentially similar to Claim 47 and is rejected for the reasons stated above apropos of Claim 47.

16. Claim 53 is essentially similar to Claim 49 and is rejected for the reasons stated above apropos of Claim 49.

17. Claim 55 is essentially similar to Claim 46 and is rejected for the reasons stated above apropos of Claim 46.

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18. Claim 56 is essentially similar to Claim 47 and is rejected for the reasons stated above apropos of Claim 47.

19. Claim 57 is essentially similar to Claim 48 and is rejected for the reasons stated above apropos of Claim 48.

20. Claim 58 is essentially similar to Claim 49 and is rejected for the reasons stated above apropos of Claim 49.

21. Claim 61 is essentially similar to Claim 47 and is rejected for the reasons stated above apropos of Claim 47.

22. Claim 62 is essentially similar to Claim 49 and is rejected for the reasons stated above apropos of Claim 49.

23. Claims 50, 51, 54, 59, 60 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erving (US Patent 4,901,346) in view of Gorman and further in view of Shenk.

24. Claim 50 claims a computer-readable storage medium containing data to direct an apparatus to perform a method as described in Claim 46. Gorman discloses a computer controlled speakerphone (Fig. 1, reference 100; column 3, lines 53-55) that uses programming (i.e., data to direct the apparatus) to perform speakerphone functions and inherently includes a memory that corresponds to the computer-readable storage medium claimed. Therefore, Gorman anticipates all elements of Claim 50 with the exception of performing a method as described in Claim 46. As stated above apropos of Claim 46, the combination of Gorman and Shenk teaches that method. It would have been obvious to one skilled in the art at the time of the invention to

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apply handset position control of the mute function as taught by the combination of Gorman and Shenk to the computer controlled speakerphone taught by Erving for the purpose of controlling the manual mute function.

25. Claim 51 claims the medium of Claim 50 further directing the apparatus to perform a method as described in Claim 47. As stated above apropos of Claim 50, the combination of Gorman, Shenk and Erving teaches all elements of that claim. In addition, as stated above apropos of Claim 47, the combination of Gorman and Shenk teaches that method. Therefore, the combination of Gorman, Shenk and Erving teaches all elements of Claim 51.

26. Claim 54 is essentially similar to Claim 51 and is rejected for the reasons stated above apropos of Claim 51.

27. Claim 59 is essentially similar to Claim 50 and is rejected for the reasons stated above apropos of Claim 50.

28. Claim 60 is essentially similar to Claim 51 and is rejected for the reasons stated above apropos of Claim 51.

29. Claim 63 is essentially similar to Claim 51 and is rejected for the reasons stated above apropos of Claim 51.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Swerdlow whose telephone number is 703-305-4088. The examiner can normally be reached on Monday through Friday between 8:00 AM and 4:30 PM.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forrester Isen can be reached on 703-305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

ds  
March 5, 2003

  
FORESTER W. ISEN  
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